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In re Application of : **OFFICE OF PETITIONS**
Fritz Kirchhofer et al :
Application No. 09/903,297 : **DECISION ON PETITION**
Filed: July 11, 2001 : **UNDER 37 CFR 1.313(c)(2)**
Attorney Docket No. 14080 : **AND 37 CFR 1.78(a)(3)**

This is a decision on the petition under 37 CFR 1.313(b)(5), filed August 20, 2003, which is being treated as a petition under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee. This is also a decision on the petition under 37 CFR 1.78(a)(3), filed August 20, 2003, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 365(c) for the benefit of priority to International Patent Application PCT/CHOO/00017, filed January 11, 2000, which claims priority to German Application 199 00 827.2.

The petitions are **DISMISSED**.

PETITION UNDER 37 CFR 1.313(c)(2)

Turning first to the petition under 37 CFR 1.313(c)(2), unfortunately, the instant petition to withdraw from issue was not received within sufficient time to avert the issuance of the above-identified application into a patent. In this regard, the petition did not reach the deciding official's office until December 23, 2003, which is after the date of issuance of the instant application into Patent No. 6,613,023 on September 2, 2003.

Petitioner's attention is directed to 37 CFR 1.313(d), which states:

A petition under this section will not be effective to withdraw the application from issue unless it is actually received and granted by the appropriate officials **before the date of issue**.

Since a petition to withdraw the instant application from issue was not granted prior to issuance of the instant application into a patent, the request for continued examination (RCE) filed concurrently with the instant petition is improper. Accordingly, the \$770 fee submitted for the RCE will be refunded to petitioner's deposit account in due course.

PETITION UNDER 37 CFR 1.78(a)(3)

As to the petition under 37 CFR 1.78(a)(3), a petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application(s), unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The petition was accompanied by items (1) through (3) above. However, because the instant application has now issued into a patent, a Certificate of Correction and documentation showing designation of states and any other information needed to make it clear from the record that the 35 U.S.C. § 120 priority is appropriate¹ must now be submitted before the petition under 37 CFR 1.78(a)(3) can be granted. *Note* MPEP 1481, page 1400-71 (Aug. 2001).

Accordingly, before the petition under 37 CFR 1.78(a)(3) can be granted, petitioner must comply with the above-noted requirements. Any request for reconsideration of this decision must be included in a Renewed Petition under 37 CFR 1.78(a)(3).

¹ See MPEP 201.13(b) as to the requirements for 35 U.S.C. § 120 priority based on an international application.

A further inspection of the instant record reveals that, although a claim for foreign priority under 35 U.S.C. § 119 to German Application No. 199 00 827.2 was lodged in a declaration under 37 CFR 1.63 filed with the application on July 11, 2001, there is no indication throughout the history of this file that a certified copy of the priority document was ever submitted prior to issuance. A certified copy of the priority document was received on February 28, 2004.

Under the rule (37 CFR 1.55), an applicant who wishes to secure the right of priority must comply with certain formal requirements within a time specific. If these requirements are not complied with, the right of priority is lost and cannot thereafter be asserted.

Specifically, the requirements of the rule are (a) that the applicant must file a claim for the right and (b) he or she must also file a certified copy of the original foreign application, and (c) these papers must be filed within a certain time limit. The maximum time limit specified in the rule is that the claim for priority and the priority papers must both be filed before the patent is granted. See 37 CFR 1.55. If the required papers are not filed within the time limit set, the right of priority is lost. As the record presently discloses that the certified copy of the priority document was not, as required by rule, filed in the above-identified application either during prosecution or prior to issuance of the application into a patent, the right of priority to the German patent application is lost.

However, a reissue was granted in *Brenner v. State of Israel*, 862 O.G. 661; 158 USPQ 584 (D.C. Cir. 1968), where the only ground urged was applicant's failure to file the certified copy of the original foreign application under 35 U.S.C. § 119 before the patent was granted. Under the circumstances of this case, petitioner may wish to seek relief from his predicament by way of reissue under 35 U.S.C. § 251. See MPEP 1417 and 201.14(a).

Further correspondence with respect to this matter should be addressed as follows:

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Any questions concerning this matter may be directed to the undersigned at
(703) 305-8680.

The patented file is being forwarded to Files Repository.


Frances Hicks

Petitions Examiner
Office of Petitions
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for Patent Examination Policy